

Mail Stop Interference
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Paper 1

Filed:
July 20, 2006

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

HAROLD R. GARNER
Junior Party
(Application 09/999,239),

v.

CALVIN F. QUATE and DAVID STERN
Senior Party
(Patent 6,271,957).

Patent Interference No. 105,445
(Technology Center 1600)

MAILED

JUL 20 2006

PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

DECLARATION - Bd.R. 203(d)¹

1 **Part A. Declaration of interference**

2 An interference is declared (35 U.S.C. § 135(a)) between the above-identified
3 parties. Details of the application(s), patent (if any), reissue application (if any),
4 count(s) and claims designated as corresponding or as not corresponding to the
5 count(s) appear in Parts E and F of this DECLARATION.

6

¹ "Bd.R. x" may be used as shorthand for "37 C.F.R. § 41.x". 69 Fed. Reg. 49960, 49961 (12 Aug. 2004).

1 **Part B. Judge managing the interference**

2 Administrative Patent Judge Jameson Lee has been designated to manage the
3 interference. Bd. R. 104(a).

4 **Part C. Standing order**

5 A Trial Section STANDING ORDER [SO] (Paper 2) accompanies this
6 DECLARATION. The STANDING ORDER applies to this interference.

7 **Part D. Initial conference call**

8 A telephone conference call to discuss the interference is set for **1:00 p.m. on**
9 **September 14, 2006** (the Board will initiate the call).

10 No later than **four business days** prior to the conference call, each party shall
11 file and serve (SO ¶¶ 10.1 & 105) a list of the motions (Bd. R. 120; Bd. R. 204;
12 SO ¶¶ 104.2.1, 120 & 204) the party intends to file.

13 A sample schedule for taking action during the motion phase appears as Form 2
14 in the STANDING ORDER. Counsel are encouraged to discuss the schedule prior to
15 the conference call and to agree on dates for taking action. A typical motion period
16 lasts approximately eight (8) months. Counsel should be prepared to justify any
17 request for a shorter or longer period.

Part E. Identification and order of the parties

Junior Party

Named inventors: Harold R. Garner, Flower Mound, TX
Involved Application: 09/999,239, filed November 29, 2001
Title: Digital optical chemistry micromirror imager
Assignee: Nimblegen Systems Inc.

Senior Party

Named Inventors: Calvin F. Quate, Stanford, CA
David Stern, Mountain View, CA
Involved Patent: 6,271,957, granted August 7, 2001
based on application 09/318,775, filed
May 26, 1999
Title: Methods involving direct write optical
Lithography
Assignee: Affymetrix, Inc.

The senior party is assigned exhibit numbers 1001-1999. The junior party is assigned exhibit numbers 2001-2999. Bd. R. 154(c)(1); SO ¶ 154.2.1. The senior party is responsible for initiating settlement discussions. SO ¶ 126.1.

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Claim 28 of Garner's Application 09/999,239.

Garner: 28-55 and 57-63

The claims of the parties which correspond to Count 1 are:

Garner: 28-55 and 57-63²

The claims of the parties which do not correspond to Count 1, and therefore are involved in the interference, are:

Garner: None

Quate: None

The parties are accorded the following benefit for Count 1:

Garner: Application 09/776,202, filed February 2, 2001
Application 09/326,526, filed June 4, 1999
Application 60/087,948, filed June 4, 1998

Quate: Application 60/087,333, filed May 29, 1998

Part G. Heading to be used on papers

2 Garner's request for interference filed October 24, 2005, did not expressly identify which of his application claims correspond to the count as required by 37 CFR § 41.202(a)(2) (requiring identification of all claims that applicant believes interfere and show how they correspond to the count). Accordingly, all of Garner's claims are considered conceded to correspond to the proposed count.

1 The following heading must be used on all papers filed in this interference, see

2 SO ¶ 106.1.1:

3
4 UNITED STATES PATENT AND TRADEMARK OFFICE

5
6
7 BEFORE THE BOARD OF PATENT APPEALS
8 AND INTERFERENCES

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10
11 HAROLD R. GARNER
12 Junior Party
13 (Application 09/999,239),

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15 v.

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17 CALVIN F. QUATE and DAVID STERN
18 Senior Party
19 (Patent 6,271,957).

20
21 Patent Interference No. 105,445
22 (Technology Center 1600)

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25 **Part H. Order form for requesting file copies**

26 When requesting copies of files, use of SO Form 4 will greatly expedite
27 processing of the request. Please attach a copy of Parts E and F of this
28 DECLARATION with a hand-drawn circle around the patents and applications for which
29 a copy of a file wrapper is requested.

/ss/Jameson Lee
Administrative Patent Judge

Enc:

Copy of STANDING ORDER
Form PTO-850
Copy U.S. Patent 6,271,957
Copy of claims of Application 09/999,239

Revised 3 January 2006

cc (via overnight delivery):

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Filed September 13, 2006

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8 UNITED STATES PATENT AND TRADEMARK OFFICE
9 BEFORE THE BOARD OF PATENT APPEALS
10 AND INTERFERENCES
11 (Administrative Patent Judge Jameson Lee)
12

13 HAROLD R. GARNER
14 Junior Party
15 (Application 09/999,239),
16
17

18 v.
19

20 CALVIN F. QUATE
21 and
22 DAVID STERN
23 Senior Party
24 (Patent 6,271,957).
25 Patent Interference No. 105,445 (JL)
26 (Technology Center 1600)
27

28 Before SCHAFER, LEE, and MOORE, *Administrative Patent Judges*.
29

30 MOORE, *Administrative Patent Judge*.
31

32 **JUDGMENT - Bd. R. 127(a)**
33

34 Garner has failed to explain why judgment should not be entered against it based
35 upon its failure to establish that it could prevail on the issue of priority. 37 CFR §
36 41.202(d) (2005).
37

38 Upon consideration of the decision on the Order to Show Cause, it is
39 **ORDERED** that judgment on priority as to Count 1 (the sole count in the
40 interference; Paper 1, page 4) is awarded against Junior Party Harold R. Garner
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